

REMARKS

Prior to this Amendment, Claims 1-34 were pending in the application. By this Amendment, Applicants have amended Claims 1, 15, and 28 and added new Claim 35. No new matter has been added by the Amendment. Reexamination and reconsideration in view of the amendments and remarks contained herein are respectfully requested.

The present application has been reviewed by the Office twice. The present application originally included Claims 1-34. In a first Office action dated October 7, 2004 (hereinafter referred to as “Action I”), Claims 1-34 were rejected. By an amendment in response to Action I, Claims 1, 6-8, 14-15, 17, 28, and 33-34 were amended. In a final Office action dated April 25, 2005 (hereinafter referred to as “Action II”), Claims 1-34 were rejected.

I. Interview Request

Applicants thank the Examiner for speaking with Applicants’ representative on June 21, 2005. It was agreed that the Examiner would not issue another action on the merits of this Amendment until an interview is held. The Examiner instructed Applicants to call the Examiner after filing this Amendment in order to schedule an interview. Applicants will call the Examiner as requested.

II. Claim Objections

Applicants have removed the repetitive language from Claim 1. As such, the Examiner’s objection to Claim 1 is overcome.

III. Claim Rejections – 35 U.S.C. § 102(e)

Claims 1-2, 6-17, 22-29, and 33-34 stand rejected under 35 U.S.C. § 102(e), as being anticipated by United States Published Application No. 2002/0065758 assigned to Henley (hereinafter referred to as “Henley”).

A. Claim 1

Henley does not teach “providing, via a patient terminal, a case statement template having one or more areas in which to specify healthcare needs of the patient and requirements

for services associated with the healthcare needs of the patient, the healthcare needs of the patient including a description of a compliant of the patient and the requirements including a date for a procedure requested by the patient,” as recited in amended Claim 1.

In Action I and Action II, the Examiner rejected Claim 1, having interpreted the “registration forms” disclosed in Henley to be a form of “case statements.”

Applicants respectfully disagree with the Examiner’s interpretation because Henley’s registration processes focus exclusively on merely enrolling a user in the system so that services can be bought or sold. As described in Henley, “[p]rior to posting the offer for sale, the system prompts the provider (seller) 70 to enter a registration identifier...[I]f the provider is not registered to offer services for sale on the system, the provider must register online” (paragraph 84). Furthermore, Henley states that a “visitor 80 may browse the various multi-linked service databases 83...[and] if the visitor wishes to buy or sell a medical service, the visitor **must first complete** a registration process by completing a buyer registration questionnaire 84 or a provider registration questionnaire 85” (paragraph 92, emphasis added).

Clearly, the registration process described in Henley is executed **before** a buyer offers to purchase a service in order to enroll the buyer with the buy-sell system such that the buyer has access to or is authorized to submit an offer. The Examiner asserted that the “broadest reasonable interpretation of the term ‘case statement’ would include data such as medical service requests and qualifications for such services, which is precisely disclosed by Henley’s ‘registration form.’”. Contrary to the Examiner’s assertion, Henley’s “registration form” **does not precisely disclose** “data such as medical service requests or qualifications for such services,” but merely includes identifying data, such as prospective buyer’s name, that allows a buyer to enroll and gain access to the buy-sell system. Fig. 14 of Henley shows “an example visitor ‘Registration’ web page provided online” (paragraph 125). As seen in Fig. 14, the ‘Registration’ web page does not allow a prospective patient to “specify clinical and non-clinical requirements of the patient” as recited in Claim 1.

However, to further clarify a distinction between “registration forms” disclosed in Henley and embodiments of “case statements,” Claim 1 has been amended to include, among other elements, “providing, via a patient terminal, a case statement template having one or more areas in which to specify **healthcare needs of the patient and requirements for services associated with the healthcare needs of the patient, the healthcare needs of the**

patient including a description of a compliant of the patient and the requirements including a date for a procedure requested by the patient.”

Henley discloses a registered buyer logging onto the system, selecting “a medical service that the buyer wishes to acquire” and proffering “a purchase price for the medical service” (paragraph 104). Henley also discloses identifying a location (e.g., a city or a state) where a “particular medical service is to be rendered” (paragraph 105). Henley, however, does not disclose a buyer or patient specifying “healthcare needs of the patient and requirements for services associated with the healthcare needs of the patient, the healthcare needs of the patient including a description of a compliant of the patient and the requirements including a date for a procedure requested by the patient,” as recited in amended Claim 1 (emphasis added).

Moreover, the Examiner’s assertion that a “registration form” is a form of a “case statement” is not applied consistently by the Examiner in rejecting the claims. For example, assuming, for the sake of argument, that a “registration form” is indeed a form of a “case statement,” Henley does not teach or suggest “preparing a case statement based on the case statement information” or “delivering the case statement to at least one contracting healthcare service provider,” as recited in Claim 1.

Henley discloses registering a prospective purchaser of services using registration forms and then allowing the prospective purchaser of services to “enter a ‘posting’ database where procedures for bidding are made available to bidders and providers can post their services and their specific requirements/conditions” (paragraph 120). Henley also discloses registering a buyer and then allowing the registered buyer to post a purchase offer, which includes “a medical service the buyer wishes to acquire” and a proffered price, “to a ‘services wanted’ bidding database” (paragraph 104). The “services wanted” bidding database is “accessible to a plurality of registered providers of medical services” (paragraph 104).

Clearly, Henley does not disclose posting information from “registration forms” to the “posting” database, and, therefore, the Examiner cannot assert that disclosing “registration forms” and an unrelated “posting” database teaches “preparing a case statement based on the case statement information.”

Henley discloses registering a prospective purchaser of services using the registration forms and performing credit qualification of the prospective purchaser (paragraphs 92 and

120). As disclosed in Henley, performing credit qualification “is done through the use of outside links with VISA, MasterCard and banking links to confirm the creditability of buyers in a similar fashion as a credit check engine are done at this time” (paragraph 120). Henley merely discloses providing information from a registration form to an outside link for qualifying creditability of a prospective purchaser of services and does not disclose “delivering the case statement to at least one **contracting healthcare service provider**,” as recited in Claim 1.

Therefore, for at least the reasons set out above, independent Claim 1 and dependent Claims 2-14, which depend on Claim 1, are allowable.

B. Claim 15

Henley does not disclose “a case statement engine configured to generate de-identified case statements based on the case statement information, the de-identified case statements excluding the unique identifying information” or “a healthcare case statement distribution engine to deliver de-identified case statements to healthcare service providers,” as recited in amended Claim 15.

As described above in connection with Claim 1, Henley does not disclose a “case statement” template or providing “case statement” information using the “case statement” template. Thus, Henley does not disclose “a case statement engine configured to generate... case statements based on the case statement information.”

As also described above, Henley discloses registering a prospective purchaser of services using a registration form or process and then allowing the prospective purchaser of services to “enter a ‘posting’ database where procedures for bidding are made available to bidders and providers can post their services and their specific requirements/conditions” (in paragraph 120). Henley also discloses registering a buyer and then allowing a registered buyer to post a purchase offer, which includes “a medical service the buyer wishes to acquire” and a proffered price, “to a ‘services wanted’ bidding database” (paragraph 104). The “services wanted” bidding database is “accessible to a plurality of registered providers of medical services” (paragraph 104).

Clearly, Henley does not disclose posting information from “registration forms” to the “posting” database, and, therefore, the Examiner cannot assert that disclosing “registration

forms” and an unrelated “posting” database teaches “a case statement engine configured to generate...case statements based on the case statement information,” as recited in Claim 15.

In addition, since Henley does not teach or suggest “a case statement engine,” Henley does not teach or suggest “a healthcare case statement distribution engine to deliver case statements to healthcare service providers,” as recited in Claim 15. To the contrary, Henley merely discloses posting a purchase offer to a database where a provider services **may or may not view the purchase offer** (paragraph 104).

However, to further clarify generation of a case statement as described in an embodiment of the present application, Claim 15 has been amended to include, among other elements, “a healthcare case statement information submission mechanism configured to provide a case statement template including areas for a patient’s clinical and non-clinical requirements and to transmit the case statement information over a network, the case statement information including **unique identifying information usable to uniquely identify the patient**” and “a case statement engine configured to generate **de-identified case statements based on the case statement information, the de-identified case statements excluding the unique identifying information.**”

As described above, Henley discloses registering a prospective purchaser of services and posting a purchase offer on a “services wanted” bidding database accessible to a plurality of registered providers of medical services. Henley **does not** disclose filtering or removing information from a purchase offer before posting the purchase offer to the “services wanted” bidding database. Therefore, Henley does not disclose “a case statement engine configured to generate de-identified case statements based on the case statement information, the de-identified case statements excluding the unique identifying information,” as recited in amended Claim 15.

Pending Claim 11' of the present application, which depends on Claim 1, includes similar de-identifying elements as included in amended Claim 15. In Action I, the Examiner rejected Claim 11 under 35 U.S.C § 102(e), citing that “Henley shows that preparing registration information includes accessing a qualifier database that stores the identification of medical service providers having satisfied a particular qualifying requirement (paragraph 94, lines 6-10 of Henley).” However, the qualifier database disclosed by Henley does not disclose “filtering unique identifying information” as recited in Claim 11 or generating de-identified case statements as recited in amended Claim 15. The qualifier database disclosed

by Henley merely “includes every service listed in the menu of medical services and the licensing requirements for providing the particular service, and hyperlinks to databases storing the identification of medical service providers having satisfied a particular qualifying requirement” (paragraph 94), and does not provide any mechanism for filtering or removing identifying data from registration information or from a purchase offer posted by a prospective buyer.

Therefore, for at least the reasons set out above, independent Claim 15 and dependent Claims 16-27, which depend on Claim 15, are allowable.

C. Claim 28

Henley does not teach or suggest “establishing case statement profile criteria for each of the plurality of contracting healthcare service providers, the case statement profile criteria configured to limit case statements to be made available to a contracting healthcare service provider based on at least one of a medical area associated with the clinical requirements of the patient, a distance between a patient location and a service location associated with the contracting healthcare service provider, and an insurance carried by the patient,” as recited in amended Claim 28. Henley also does not teach or suggest “making the case statement available to each contracting healthcare service provider whose profile criteria matches the case statement,” as recited in amended Claim 28.

The portion of Henley referenced by the Examiner (paragraph 104, lines 1-10) as teaching “establishing case statement profile criteria for each of a plurality of contracting healthcare service providers,” specifies registration forms for providers of services and buyers of services. The registration forms of Henley merely provide a mechanism for a provider of services to list his or her “qualifications” for providing services and provide a mechanism for a buyer of services to list his or her “credit worthiness.” Therefore, registration forms as disclosed in Henley do not teach or suggest “establishing case statement profile criteria...,” as recited in Claim 28.

Furthermore, Henley discloses allowing “registered” service providers to access the “posting” database, but, once a service provider is registered, Henley **does not** disclose filtering or restricting access to particular case statements based on profile criteria. Therefore, merely restricting “unregistered” service providers from accessing a “posting” database, as taught in Henley, does not disclose “making a case statement available to each

contracting healthcare service provider whose profile criteria matches the case statement,” as recited in Claim 28.

However, to further clarify embodiments of profile criteria as described in the present application, Claim 28 has been amended to include, among other elements, “establishing a case statement profile criteria for each of the plurality of contracting healthcare service providers, the case statement provider criteria configured to limit case statements to be made available to a contracting healthcare service provider based on at least one of a medical areas associated with the clinical requirements of the patient, a distance between a patient location and a service location associated with the contracting healthcare service provider, and an insurance carried by the patient.”

As described above, Henley merely discloses only allowing “registered” service providers to access the “posting” database, but once a service provider is “registered,” Henley does not disclose limiting “case statements to be made available to a contracting healthcare service provider based on at least one of a medical area associated with the clinical requirements of the patient, a distance between a patient location and a service location associated with the contracting healthcare service provider, and an insurance carried by the patient,” as recited in amended Claim 28.

Therefore, for at least the reasons set out above, independent Claim 28 and dependent Claims 39-34, which depend on Claim 28, are allowable.

D. New Claim 35

New Claim 35 recites a method of selling healthcare services to a patient, the method comprising, among other elements, “providing a referring physician template having one or more areas in which to specify information concerning the patient’s referring physician.”

Henley merely discloses a buyer selecting “a medical service that the buyer wishes to acquire” and proffering “a purchase price for the medical service” (paragraph 104). Henley also discloses identifying a location (e.g., a city or a state) where a “particular medical service is to be rendered.” Clearly, Henley does not disclose “providing a referring physician template having one or more areas in which to specify information concerning the patient’s referring physician,” as recited in new Claim 35.

Pending Claim 21 of the present application, which depends on Claim 15, includes similar referring physician template elements, as included in new Claim 35. In Action I, the Examiner recognized that Henley did not disclose a “referring physician template,” but rejected Claim 21 under 35 U.S.C § 103(a), as being unpatentable over Henley in view of U.S. Patent No. 5,519,607 issued to Tawil (hereinafter referred to as “Tawil”).

Tawil discloses “an automated health benefit processing system which includes a database and processing means for performing processing health benefit claims that result when an insured seeks medical services. The database lists, for each geographic area and for each medical procedure which can be performed...the benefit payable if the designated medical procedure is prescribed and performed, a list of providers available to perform the designated procedure and each provider’s charge for performing the designated procedure” (col. 1, lines 41-50).

“When medical services are required by an insured patient,...[a] physician generates a treatment plan for the insured patient” (col. 3, lines 45-53). The treatment plan includes information entered by the physician and information retrieved from the database. “The retrieved information includes a list of providers able to perform [services]...and their prices for doing so” (col. 4, lines 25-27).

The treatment plan and the appended provider information...[are made] available for review by the patient to assist the patient’s decision making process” (col. 4, lines 55-57).

The Examiner interpreted the “list of providers” disclosed in Tawil to be a form of a “referring template.” However, contrary to the Examiner’s interpretation, the “list” disclosed in Tawil merely lists physicians available to perform a particular procedure and does not teach or suggest “providing a referring physician template **having one or more areas in which to specify information concerning the patient’s referring physician**,” as recited in new Claim 35 (emphasis added).

Therefore, for at least the reasons set out above, new Claim 35 is allowable.

IV. Claim Rejections – 35 U.S.C. § 103(a)

A. Claims 4-5, 19-21, and 31-32

Claims 4-5, 19-21, and 31-32 stand rejected under 35 U.S.C § 103(a), as being unpatentable over Henley in view of Tawil. In light of the deficiencies of Henley set out

above, none of which is remedied by Tawil, Applicants submit that the proposed combination of Henley and Tawil does not meet all of the claim limitations of Claims 4-5, 19-21, and 31-32.

As noted, Tawil is directed to assisting the decision making process of a patient by generating a list of providers available to perform a designated procedure. Tawil, however, does not teach “providing, via a patient terminal, a case statement template,” “transmitting case statement information specified in the cast statement template over a network,” “preparing a case statement based on the case statement information,” and “delivering the case statement to at least one contracting healthcare service provider,” as recited in Claim 1, which Claims 4-5 depend from. Tawil also does not teach “a case statement engine configured to generate de-identified case statements based on...case statement information, the de-identified case statements excluding...unique identifying information,” as recited in Claim 15, which Claims 19-21 depend from. Furthermore, Tawil does not teach “establishing case statement profile criteria for each of the plurality of contracting healthcare service providers,” as recited in Claim 28, which Claims 31-32 depend from. Thus, the combination of Henley and Tawil does not teach the subject matter of the independent claims of the present application.

Accordingly, Claims 4-5, which depend on independent Claim 1, are therefore allowable for at least the reasons set out above with respect to Claim 1. Claims 19-21 depend on independent Claim 15 and are allowable for at least the reasons set out above with respect to Claim 28. Claims 31-32 depend on independent Claim 28 and are allowable for at least the reasons set out above with respect to Claim 28. Claims 4-5, 19-21, and 31-32 also include additional patentable subject matter not specifically discussed herein.

B. Claims 3, 18, and 30

Claims, 3, 18, and 30 stand rejected under 35 U.S.C § 103(a), as being unpatentable over Henley in view of Tawil and further in view of U.S. Patent No. 6,584,445 issued to Papageorge (hereinafter referred to as “Papageorge”). In light of the deficiencies of Henley set out above, none of which is remedied by Tawil or Papageorge, Applicants submit that the proposed combination of Henley, Tawil, and Papageorge does not meet all of the claim limitations of Claims 4-5, 19-21, and 31-32.

Papageorge discloses a computerized health evaluation system for joint patient and physician decision making concerning particular medical diseases and conditions. The system includes a computer system with a patient input module for patient input of patient data concerning the patient's lifestyle and preferences, a physician input module for physician input of physical and physiological data, and a database of the latest medical findings concerning the particular disease and condition. The computer system uses an algorithm for weighing the patient data and the physician data in view of the database and generating a report setting forth various treatment options. Based upon the report, the patient and physician will jointly decide on a treatment approach" (abstract).

Papageorge, however, does not teach "providing, via a patient terminal, a case statement template," "transmitting case statement information specified in the cast statement template over a network," "preparing a case statement based on the case statement information," "delivering the case statement to at least one contracting healthcare service provider," as recited in Claim 1, which Claim 3 depends from. Papageorge also does not teach "a case statement engine configured to generate de-identified case statements based on...case statement information, the de-identified case statements excluding...unique identifying information," as recited in Claim 15, which Claim 18 depends from. Furthermore, Papageorge does not teach "establishing case statement profile criteria for each of the plurality of contracting healthcare service providers," as recited in Claim 28, which Claim 30 depends from. Thus, the combination of Henley, Tawil, and Papageorge does not teach the subject matter of the independent claims of the present application.

Accordingly, Claim 3, which depends on independent Claim 1, is therefore allowable for at least the reasons set out above with respect to Claim 1. Claim 18 depends on independent Claim 15 and is allowable for at least the reasons set out above with respect to Claim 28. Claim 30 depends on independent Claim 28 and is allowable for at least the reasons set out above with respect to Claim 28. Claims 3, 18, and 30 also include additional patentable subject matter not specifically discussed herein.

CONCLUSION

In view of the above, entry of the amendment, reexamination and reconsideration in view of the amendments and remarks contained herein, and allowance of pending Claims 1-34 and new Claim 35 are requested. As previously noted, the Applicants also request a telephone interview to be held before the Examiner prepares a response to this communication.

Respectfully submitted,



Derek C. Stettner
Reg. No. 37,945

File No. 073352-9003-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560

X:\clientb\073352\9003\A1213891.1